IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
    Condon, Pat et al

Serial No. 09/467,706

Filed: December 20, 1999

For: APPARATUS AND METHOD FOR
      CONFIGURING COMPUTERS

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Confirmation No.: 2712

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Examiner: Retta, Yehdega

REPLY BRIEF IN RESPONSE TO 37 CFR §41.41

Mail Stop Appeal Briefs – Patent
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

This Paper is submitted pursuant to 37 CFR §41.41 as a Reply Brief to the Examiner's Answer, mailed on February 9, 2007.

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1.   **Status of Claims**

The status of the claims is as follows:

Claims 1, 4, 12-16 and 19 are pending in the application and are rejected.

Claims 2, 3, 5-11, 17-18 and 20-22 are canceled.

Claims 1, 4, 12-16 and 19 are being appealed.

2. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1, 4, 12-16 and 19 are unpatentable under 35 U.S.C. § 103(a) over Dharnipragada (U.S. 6,490,493) ("Dharnipragada") in view of Kroenig et al (U.S. 6,080,207) ("Kroenig"), further in view of Knowles et al (U.S. 6, 182,897) ("Knowles").

3.   **Background and Introduction**

The rejections in this application are based on three references: (1) Dharnipragada
(U.S. 6,490,493) ("Dharnipragada"); (2) Kroenig et al (U.S. 6,080,207) ("Kroenig"); and (3)
Knowles et al (U.S. 6,182,897) ("Knowles"). In the Appeal Brief, Applicants argue that:

Independent claim 1 includes: a manufacturer providing a manufacturer web page unit,
a manufacturer office unit and a manufacturer plant; a customer sending a main order
for the computer to the office unit via a web page in the web page unit, the customer
being required to indicate if a special configuration is desired; passing elements of the
main order to a control unit in the manufacturing plant unit; the control unit controlling
manufacturing and supply lines containing a plurality of compatible hardware and
selected software components for installation into the computer being manufactured;
the customer entering any special configuration details to the web page unit; passing
the web page to a modification unit in the office unit; passing the special configuration
details to a validation unit in the office unit; the validation unit checking the special
configuration details for compatibility with details of the main order; upon validation,
sending the special configuration details to the control unit; the control unit detecting
any modification details in the main order details and obtaining corresponding
configuration details from the modification unit; the control unit checking the
configuration details with a factory database for implementation; and the control unit
entering appropriate data into the computer being manufactured including entering
modification details in appropriate ones of the selected software components which are
being installed or have been installed in the computer.

Once the desired configuration has been specified on the Web page 31, the page is
passed to a modification unit 37 in the office unit 35. The configuration details in the
modification unit are then passed to a validation unit 38, which is also fed with the
details of the order from the order unit 36. The validation unit 38 checks for
consistency between the order details and the configuration details. The validation unit
is also supplied with general information about the current capabilities of the
manufacturer, and checks those details for compatibility with the order details and
configuration details (block 14).

Once the configuration details have been validated, they are made available to the
control unit 46 in the manufacturing plant. This control unit detects any modification
flag in the order details coming from the order unit 36 (block 16) and obtains the
corresponding configuration details from the unit 37. Next, the control unit checks
those details with the factory database to determine how to implement them (block 17).
The control unit then enters the appropriate data into the computer 48 being
manufactured (block 18). This will normally involve entering the details in the
appropriate ones of the software packages which are being or have been loaded from
the software supply line 50. The completed computer is then shipped to the customer
(block 19).

In Dharnipragada, "If the order is changed prior to beginning manufacturing of the
process device, the change order may be implemented. If the order is changed after

the beginning of manufacturing of the process device, the change order is entered into the order database, but the process device will likely be built according to the original order." (col. 6, lines 9-14).

In the invention, the control unit enters appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer.

In Kroening, "In block 212, the image builder 20 compares the configuration IDs to the configuration history. If the configuration ID corresponds to a previously configured image, then the image builder 20 looks at whether the image is in a storage device 30, as illustrated in FIG. 1. If the image is found in the storage device 30, then block 224 flags the configuration as ready for delivery and notifies an operator of the computerized network 10 that a desired image is ready. Otherwise, if the image is not found in the storage device 30, the image is created by the image builder 20 according to block 216 as a fresh build. As part of the fresh build process, block 230 requires the image builder 20 to process the bill of materials to determine the parameters for building an image according to the desired software configuration and ensure that they are compatible with the customer's hardware, software and special requirements. The final result or output from block 230 is an image or "digital picture" of the desired software configuration according to the bill of materials.

In the invention, "Once the desired configuration has been specified on the Web page 31, the page is passed to a modification unit 37 in the office unit 35. The configuration details in the modification unit are then passed to a validation unit 38, which is also fed with the details of the order from the order unit 36. The validation unit 38 checks for consistency between the order details and the configuration details. The validation unit is also supplied with general information about the current capabilities of the manufacturer, and check those details for compatibility with the order details and configuration details (block 14).

Knowles teaches a web-enabled system and method for designing and manufacturing laser scanners.

The invention uses the manufacturers web page to place an order for a specially configured computer system.

The fact that a manufacturer web page is utilized in these instances is insufficient to overcome the vast differences between the claimed invention and the combination of references as set forth above.

The invention provides a method of automatically manufacturing a computer. A major difference between the invention and the references involves the handling and implementation of special configuration details.

In response to the Applicant's argument, the Examiner argued that (copied verbatim including grammatical and/or typographical errors):

> Appellant argues that the references alone or in combination do not teach or even suggest all the limitations of the claimed.
>
> Appellant assets that in the invention, claim 1, the customer being required to indicate if a special configuration is desired and in the specification "in addition, the customer must include, in the main order which is passed to the order unit and indication that a special configuration is desired." Appellant further states that the invention also claims "the control unit entering appropriate data into the computer being manufactured including entering modification details in the appropriate ones of the selected software components which are being installed or have been installed in the computer."
>
> Appellant argues that in Dharnipragada, if the order is changed prior to beginning manufacturing of the process device, the change order may be implemented...Appellant asserts in Dharnipragada the inventor may change the order at any time during the manufacturing process and is not "required" to indicate if there is a special configuration. Examiner agrees that the system of Dharnipragada allows the customer to change the order after the order has been sent to the manufacturing, i.e., after the special order is made.
>
> Appellant's invention requires a web page to enter a customer order. According to the specification, the customer places an order and a reference number for the order. If there are any special configuration requirements, the customer compiles the specification configuration information required, and passes this to the manufacturer over the Internet; the manufacturer passes the information to a validation system which checks the modification; a special modification indicator in the order, flags the system to look for specific configuration data (see page 5).
>
> Dharnipragada also teaches a computer input to define the operating requirements for a process device; the process requirement is then imported electronically to the design computer. The process requirements for a point in the process plant are organized under a unique identifier known as a Tag, which represents a specific process device. The system then Evaluates the process requirements against predetermined process device data, the software execute numerous validation checks to ensure the process devices selected are compatible with the process requirements. Examiner would like to point out that specifying a special order is an indication that a special configuration is desired.
>
> Examiner is aware that the Dharnipragada's system is not for specifying computer order, instead provides an interface for specifying process devices such as measurement instruments and valves, and the system also does not provide a web page. Nevertheless Dharnipragada teaches an interface for customer to specify a special order. Examiner also aggress that Knowles provides a web-enabled system and method for designing and manufacturing a laser scanner, not a computer system. The fact is that Knowles teaches a web page to place a specially configured product such as a laser scanner. Kroenig teaches a computerized system and method for

generating a customer software configuration for a hard drive of a computer system according to desired software configuration defined by a purchasing customer (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art a the time of appellant's invention was made to use Dharnipragada's interface, as modified by Knowles web page, to order a special configuration computer, as in Kroenig.

Therefore, in combination the reference teaches appellant's invention as claimed.

4. **Argument**

Dharnhipragada fails to teach, suggest, or render obvious at least "a customer sending a main order for the computer to the office unit via a web page in the web page unit, the customer being <u>required to indicate if a special configuration is desired</u>" as required by claim 1. The Examiner's response to Applicants' argument that the customer in Dharnipragada is not required to indicate if a special configuration is desired is not persuasive on that issue. According to the Examiner's Answer, "Examiner agrees that the system of Dharnipragada allows the customer to change the order after the order has been sent to the manufacturing, i.e., after the special order is made" and "Examiner would like to point out that specifying a special order is an indication that a special configuration is desired." However, modifying an existing order does not teach indicating a special configuration. More specifically, allowing the customer to change the order after the order has been sent to the manufacturer does not teach being required to indicate if a configuration which differs from the standard default configuration is desired. According to the patent application, a special configuration is, in other words, "a configuration which differs from the standard default configuration." Page 7, Lines 15-18. There has to be a standard default configuration in order to have a configuration which differs from the standard default configuration, and Dharnipragada does not teach a standard default configuration or a special configuration. Furthermore, Dharnipragada teaches, at best, entering process device configuration details for a particular model number. This teaching does not rise to the level of, nor render obvious, "a customer sending a main order for the computer to the office unit via a web page in the web page unit, the customer being <u>required to indicate if a special configuration is desired</u>" as required by independent claim 1.

Additionally, the Examiner's response does not appear to distinguish between the limitation of indicating if a special configuration is desired and the limitation of entering special configuration details. In fact, the Examiner appears to use the limitations interchangeably. However, "the customer being required to indicate if a special configuration is desired" and "the customer entering any special configuration details" are two separate limitations as currently claimed. Although it may be argued that if the customer is entering special configuration details it is impliedly suggested that the customer desires a special configuration, it does not teach the customer being required to indicate if a special configuration is desired, which would require an explicit act by the customer. This error in the Examiner's logic further supports the fact that the teaching in Dharnipragada does not rise to the level of, nor render obvious, "a customer

sending a main order for the computer to the office unit via a web page in the web page unit, the customer being <u>required to indicate if a special configuration is desired</u>" as required by independent claim 1, and those that depend therefrom.

Moreover, Knowles and Kroenig fail to remedy the deficiencies of Dharnipragada and the Examiner has made no argument to the contrary. Knowles teaches a customer providing a specification of his scanning requirements. According to Knowles, "the first step of the method of the present invention involves the end-user...using a client computer system ...to provide a specification of the end-user's scanning requirements." Col. 4, Lines 36-40; Figure 3. This does not teach a customer being required to indicate if a special configuration is desired. At best, this teaches the customer entering special configuration details.

Kroenig teaches a customer selecting software configuration details, but does not teach requiring the customer to indicate if a special configuration is desired. According to Kroenig, "a desired software configuration [is] defined by a purchasing customer." Col. 2, Lines 1-6. This does not teach a customer being required to indicate if a special configuration is desired. At best, this teaches the customer entering special configuration details.

Furthermore, the Examiner's response to Applicants' argument that a "major difference between the invention and the references involves the handling and implementation of special configuration details" is not persuasive on that issue. The handling and implementation of special configuration details includes "passing the special configuration details to a validation unit in the office unit; the validation unit checking the special configuration details for compatibility with details of the main order; upon validation, sending the special configuration details to the control unit; the control unit detecting any modification details in the main order details and obtaining corresponding configuration details from the modification unit; the control unit checking the configuration details with a factory database for implementation; and **the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer**" as is currently claimed. The Examiner fails to address the limitations of claim 1 reproduced above in boldface type; namely, "the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer." The

Examiner appears to consider "modification" to refer to an order being changed after it is placed, but this is not how the word "modification" is used in the specification. According to the application, modification details can be checked for in the main order that the customer originally sent to the office unit via a web page. Page 8, Lines 6-8. According to claim 1, "the control unit detect[s] any modification details in the main order details." As such, Dharnipragada fails to teach "the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer" as required by independent claim 1, and those that depend therefrom.

Moreover, Knowles and Kroenig also fail to teach "the control unit entering appropriate data into the computer being manufactured including entering modification details in appropriate ones of the selected software components which are being installed or have been installed in the computer," and the Examiner has made no argument to the contrary.

Additionally, Dharnipragada also fails to teach "the control unit detecting any modification details in the main order details and obtaining corresponding configuration details." Applicants again point out that the Examiner appears to consider "modification" to refer to an order being changed after it is placed, which is not how the word "modification" is used in the specification, as discussed above. According to the specification, "[t]he control unit detects any modification flag in the order details coming from the order unit 36 (block 16) and obtains the corresponding configuration details from the unit 37." Page 8, Lines 6-8. According to Page 3 of the Examiner's Answer, "Dharnipragada teaches...detecting modification flag and obtaining corresponding configuration details (col. 4, lines 10-30, col. 5, lines 30-50)." Page 3, Lines 13-22. However, what Dharnipragada actually teaches at the specified pages is a software having import and export features that allows a user to create a specified process device index showing summary information process devices. According to Dharnipragada, "[t]he software contains import and export features that allow users to electronically import process data, perform sizing and selection, and then export the process device specifications to existing databases" and "a specified process device index can be created showing summary information on each specified process device." Col. 4, Lines 16-19; Col. 5, Lines 44-46. Allowing users to import and export process device specifications does not teach detecting any modification details in the main order and obtaining corresponding configuration details.

Moreover, Knowles and Kroenig also fail to teach "the control unit detecting any modification details in the main order details and obtaining corresponding configuration details," and the Examiner has made no argument to the contrary.

5.   **Legal Precedent**

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the <u>subject matter as a whole</u> would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, <u>all limitations of the claim must be evaluated</u>. However, the references, alone, or in combination, do not teach the invention as a whole.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

6. Conclusion

In view of the foregoing, it is respectfully submitted that the various combinations of references fail to teach or suggest the subject matter of claims 1, 4, 12-16 and 19. For all of the foregoing reasons, it is respectfully submitted that claims 1, 4, 12-16 and 19 be allowed and a prompt notice to that effect is earnestly solicited.

Respectfully submitted,

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